

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Connie Sanchez et al.

Application No.: 10/644,588

Confirmation No.: 5265

Filed: August 20, 2003

Art Unit: 1617

For: THE USE OF ENANTIOMERIC PURE
ESCITALOPRAM

Examiner: T. E. Betton

PETITION UNDER 37 C.F.R. § 1.181
TO WITHDRAW HOLDING OF ABANDONMENT

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Petition to withdraw the holding of abandonment in the Notice of Abandonment mailed December 3, 2009 for the above-identified patent application (copy enclosed as Exhibit A). For the reasons set forth below, the Notice of Abandonment is in error and should be withdrawn.

The Notice of Abandonment states that the application was abandoned due to Applicant's failure to reply to the May 29, 2009 Office Action. This is incorrect because a Response to the May 29, 2009 Office Action was timely filed in the USPTO on November 24, 2009 concurrently with a Petition and fee for a three-month extension of time under 37 CFR §1.136(a). A copy of the Certificate of Express Mailing Under 37 CFR §1.10 identifying these timely filed documents is enclosed as Exhibit B.

The Notice of Abandonment also states that Applicant's counsel, the undersigned, "confirmed that no further action would be taken on application 10/644588" during a telephonic interview held November 30, 2009. *See* Notice of Abandonment and Interview Summary. This, too, is incorrect. As set forth herein, Applicant filed a timely response to the May 29, 2009 Office

Action and, by doing so, clearly indicated its intention to continue prosecution of the application. Furthermore, Applicant's counsel, the undersigned, has no recollection of having made any such statement during a November 30, 2009 telephonic interview with the Examiner indicating that this application would be abandoned. On the contrary, Applicant's counsel, the undersigned, took action on this application six days before the Examiner's documented interview by filing a timely response to the May 29, 2009 Office Action.

Given the foregoing, Applicant respectfully submits that this application has not been abandoned and therefore requests withdrawal of the holding of abandonment and reinstatement of the application. It is believed that no fee is due with this Petition under 37 C.F.R. § 1.181. However, should the Commissioner find that a fee is due, the USPTO is hereby authorized to charge any such fee to Deposit Account No. 04-0100.


* * * * *

Alternative Petition to Revive Under 37 C.F.R. §1.137(b)

It is respectfully submitted that the foregoing evidence is an adequate showing that the holding of abandonment should be withdrawn. However, in the alternative, it is respectfully submitted that abandonment of this application was unintentional under 37 C.F.R. §1.137(b) and that the application should be revived because the abandonment of the application and the entire delay from the due date of the reply until the filing of this Petition pursuant to 37 C.F.R. §1.137(b) was unintentional. Accordingly, if deemed necessary, the Commissioner is authorized to charge the fee under 37 C.F.R. §1.17(m) for the Petition to Revive to Deposit Account No. 04-0100.

Dated: December 14, 2009

Respectfully submitted,

By 
Dianna Goldenson

Registration No.: 52,949
DARBY & DARBY P.C.
P.O. Box 770
Church Street Station
New York, New York 10008-0770
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

J. LESSLER

12/4/09

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------------|
| 10/644,588 | 08/20/2003 | Connie Sanchez | 05432/100M919-US3 | 5265 |
| 7278 7590 12/03/2009 DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770 | | | EXAMINER BETTON, TIMOTHY E | |
| | | | ART UNIT 1627 | PAPER NUMBER |
| | | | MAIL DATE 12/03/2009 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|--------------------------|------------------------|---------------------|--|
| Interview Summary | Application No. | Applicant(s) | |
| | 10/644,588 | SANCHEZ ET AL. | |
| | Examiner | Art Unit | |
| | TIMOTHY E. BETTON | 1617 | |

All participants (applicant, applicant's representative, PTO personnel):

(1) TIMOTHY E. BETTON. (3) _____.

(2) Dianna Goldensen. (4) _____.

Date of Interview: 30 November 2009.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____.

Claim(s) discussed: _____.

Identification of prior art discussed: _____.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: It was confirmed that no further action would be taken on application 10/644588.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

TEB

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Notice of Abandonment

Application No.

10/644,588

Applicant(s)

SANCHEZ ET AL.

Examiner

Art Unit

TIMOTHY E. BETTON

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 29 May 2009.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

It was confirmed that no further action would be taken on application 10/644588. An interview summary is also attached.

TEB

/Yong S. Chong/
Primary Examiner, Art Unit 1627

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

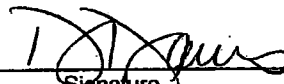
EXHIBIT B

Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. *Em061012475-US* in an envelope addressed to:

MS RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on November 24, 2009
Date


Signature
D. Davis

Typed or printed name of person signing Certificate

Registration Number, if applicable

Telephone Number

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Request for Continued Examination (RCE) Transmittal (1 p.)
Response to Final Office Action Accompanying RCE (6 pp.)
Exhibit A (2 pp.)
Exhibit B (3 pp.)
3-Month Request for Extension of Time Under 37 CFR 1.136(a) (1 p.)
Fee Transmittal (1 p.)
Certificate of Express Mailing (1 p.)
Charge \$1,920.00 to Deposit Account No. 04-0100